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Toshiyasu Yabe

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EXAMINER

NILANONT, YOUAPAPORN

ART UNIT

PAPER NUMBER

2446

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,114	Applicant(s) YABE ET AL.	
	Examiner YOUAPORN NILANONT	Art Unit 2446	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims:

Claims 13-32 are pending in this Office Action.

Claims 1-12 are cancelled.

Claims 13-32 are new.

The objection to the title is withdrawn based on applicant's amendment.

Response to Arguments

1. Applicant's arguments filed in the amendment filed on 4/22/2009 have been considered but are moot in view of the new ground(s) of rejection. The reasons set forth below.

Applicant's invention as claimed:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13, 15-19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (US 6842773) in view of Wilson (US 2004/0015554).

As per claim 13, (New) Ralston discloses an email delivery system (Ralston, figure 1 “mail system 112” and column 3 lines 60-61), comprising:

a terminal station accommodated in a first communication network (Ralston, figure 1 “user 116” and column 3 lines 60-62), the terminal station configured to receive emails from senders transmitted via the first communication network (Ralston, figure 1 “Internet 108” and column 3 lines 54-56, 60-65);

the terminal station further configured to receive identification information from a transmitting apparatus of a respective sender responsive to a user registration request, the transmitting apparatus accommodated in a second communication network (Ralston, column 3 lines 40-44); the terminal station further configured to transmit the received identification information of the respective sender over the first communication network (Ralston, column 3 lines 40-44); and

a relay apparatus configured to receive the identification information of the respective sender transmitted from the terminal station over the first communication network, and store the received identification information in association with an email address of a user of the terminal station (Ralston, figure 2 “approved list 116”, column 4 lines 58-67, column 5 lines 1-3);

the relay apparatus further configured to receive all emails forwarded from the second communication network to the first communication network (Ralston, figure 1 “mail system 112” and column 3 lines 45-48); and

the relay apparatus further configured to forward to the terminal station only those emails that include the identification information stored by the relay apparatus in association with the email address of the user of the terminal station (Ralston, column 4 lines 55-65).

Ralston reference does not explicitly teach that the relay apparatus controls the terminal station to register the email address of the user of the terminal station as a recipient email address at the transmitting apparatus of the sender identified with the identification information.

However, Wilson reference discloses an email system that notifies user of an email from an unknown sender and prompts the user for his decision whether to receive that email (Wilson, page 3 [0028] and page 7 [0087]).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have modified the Ralston email system to prompt for user's response in deciding whether to receive messages from senders not currently on the list, in order to automate the process of entering new sender into a list of allowed or blocked senders without extra effort from the user and therefore register that the user's email is the recipient of that sender.

As per claim 15, (New) Ralston in view of Wilson teaches the email delivery system according to Claim 13, wherein the identification information of the respective sender is a prescribed number of characters that begin an email address of the respective sender (Ralston, column 6 lines 5-7 and column 20 lines 38-31, Wilson, page 7 [0082] 'postmaster' or 'route').

As per claim 16, (New) Ralston in view of Wilson teaches the email delivery system according to Claim 13, wherein the identification information of the respective sender is configured as a prescribed number of characters that end an email address of the respective sender (Ralston, column 5 lines 4-5 “domains”).

As per claim 17, (New) Ralston in view of Wilson discloses the email delivery system according to Claim 13, wherein the transmitting apparatus of the respective sender is a plurality of transmitting apparatuses of a plurality of respective senders each having different identification information (Ralston, column 3 lines 40-44),

the terminal station further configured to prompt a user of the terminal station to select one of the plurality of respective senders for whom identification information is received (Ralston, column 4 lines 66-67, column 5 lines 1-3), and

the terminal station further configured to transmit the identification information of the one of the plurality of respective senders to the relay apparatus in response to selection by the user of the one of the plurality of respective senders (Ralston, column 3 lines 40-44, column 4 lines 66-67, column 5 lines 1-3).

As per claim 18, (New) Ralston in view of Wilson teaches the email delivery system according to Claim 13, wherein the relay apparatus is further configured to control the terminal station to provide a user interface (Ralston column 3 lines 51-54) to transmit the identification information to the relay apparatus, and the relay apparatus is further configured to receive the identification information transmitted in response to a user input received via the user interface (Ralston column 3 lines 54-56).

As per claim 19, (New) Ralston in view of Wilson discloses the email delivery system according to Claim 18, wherein the relay apparatus is further configured to transmit to the terminal station a file, written in a prescribed language, the file describing procedures to provide the user interface and to cause the terminal station to forward the identification information to the relay apparatus in response to receipt of the user input (Wilson, page 7 [0087] “pop-up window...prompt user to decide...”).

As per claim 24, (New) Ralston in view of Wilson discloses the email delivery system according to Claim 13, wherein the identification information comprises a registration screen, and

the terminal station is further configured to provide the registration screen in a user interface to prompt for transmittal of the identification information to the relay apparatus (Wilson, [0087] “a pop-up window”), and

the relay apparatus is further configured to receive an identifier of the terminal station and a delivery permission request transmitted in response to a user input to the registration screen received via the user interface (Wilson, [0087] “block the sender’s address”).

4. Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) in view of Wilson (U.S. Patent Application Publication No. 2004/0015554) as applied to claim 13 above, and further in view of common knowledge in the art.

As per claim 14, (New) The email delivery system according to Claim 13.

Ralston and Wilson do not explicitly disclose that the identification information of a sender is assigned in the second communication network to identify a sender of an email. However, it was commonly known in the art that the sender's email address as specified and used as sender's identification in both Ralston and Wilson references are assigned in the sender's own network and not in the receiver's network.

Therefore, it would have been obvious to the person having ordinary skill in the art, at the time the invention was made to have assumed that the sender's email address was assigned to the sender by the sender's network in order to conform to the existing email system without additional effort.

As per claim 22, (New), Ralston in view of Wilson discloses the email delivery system according to Claim 13.

Ralston and Wilson do not explicitly state wherein on receiving the identification information transmitted from a terminal station, the relay apparatus determines whether to allow the user of the terminal station to make use of the relay apparatus itself, only in the case of allowing the user, the relay apparatus obtains an email address of the user, and stores the obtained email address corresponding to the identification information transmitted from the terminal station.

However, it was commonly known in the art at the time of the invention that any mail system such as used in Ralston reference (Ralston column 3 lines 45-67) requires a login by the user of such terminal before he can access his emails. Therefore, it would have been obvious to the person of ordinary skill in the art, at the time the

invention was made, to have included a user login page prompted by the terminal in Ralston email system for the security and privacy purposes.

5. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) and Wilson (U.S. Patent Application Publication No. 2004/0015554) as applied to claim 19 above, and further in view of Mathur et al. (US 6581072).

As per claim 20, (New) The email delivery system according to Claim 19, wherein the terminal station is further configured to transmit the identification information (Wilson, page 7 [0087] “pop-up window...prompt user to decide...reject it (and block the sender’s address)”) and then delete the file transmitted from the relay apparatus.

Ralston in view of Wilson does not explicitly disclose that the terminal station deletes the file transmitted from the relay apparatus. However, Mathur reference discloses a system that allows the user to delete web page cookies in order for user to preserve privacy (Mathur, column 15 lines 10-13, 15-16).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have used Mathur technique of deleting cookies or transmitted files in Ralston’s and Wilson’s terminal station in order to protect privacy of the user of the terminal station (Mathur, column 15 lines 15-16).

As per claim 21, (New) Ralston in view of Wilson discloses the email delivery system according to Claim 19, but does not explicitly disclose wherein the relay

apparatus is further configured to prohibit the terminal station from storing a locator of the file indicative that the file was provided from the relay apparatus.

However, Mathur reference discloses a system that provides filter that allows automatic deletion of web page cookies in order for user to preserve privacy (Mathur, column 15, lines 13-20).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have used Mathur technique of deleting cookies or transmitted files in Ralston's and Wilson's terminal station in order to protect privacy of the user of the terminal station (Mathur, column 15 lines 15-16).

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) and Wilson (U.S. Patent Application Publication No. 2004/0015554) as applied to claim 13 above, and further in view of Adkins (US 2004/0243844).

As per claim 23, (New) Ralston in view of Wilson discloses the email delivery system according to Claim 13, wherein the terminal station obtains from a sender of an email identification information, the identification information identifying a sender of an email the terminal station transmits to the relay apparatus the obtained identification information (Ralston, column 3 lines 40-44), the relay apparatus receives the identification information (Ralston, column 4 lines 49-61).

Ralston and Wilson do not teach the system wherein the terminal station transmits to the relay apparatus time information indicating a time of obtaining the

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identification information, the relay apparatus receives the time information transmitted from the terminal station, only in the case that difference between the time indicated by the received time information and the time of receiving the time information are shorter than a prescribed time, the relay apparatus stores the received identification information corresponding to the email address of the user of the terminal station.

However, the Adkins reference teaches an email system with unwanted email filter that allows the user to filter the temporary list to include only identification of sender of message sent within a specified time wherein the user is able to add a sender's identification in that temporary list to the inclusive list (page 4 [0065]-[0067]).

It would have been obvious to the person of ordinary skill in the art, at the time the invention was made, to have included such timing feature as taught by Adkins into modified Ralston's email system, in order to automatically limit the number of sender's identification to be added to the user's inclusive list.

7. Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) in view of Wilson (U.S. Patent Application Publication No. 2004/0015554) and in view of Castell et al. (US 2002/0132607).

As per claim 25, (New) Ralston discloses a relay apparatus (Ralston, figure 2 "112"), comprising:

a first communication unit configured to receive identification information from a terminal station over a first communication network, the identification information

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identifying a sender of an email which a user of the terminal station wishes to receive (Ralston, column 3 lines 40-44);

a storage unit configured to Store the identification information received by the first communication unit in association with an email address of the user of the terminal station (Ralston, figure 2 “approved list 216”);

a second communication unit configured to receive emails over a second communication network (Ralston, figure 6A “begin receiving mail message from Internet 604”),

the processor further configured to forward to the terminal station over the first communication network those received emails confirmed to include the identification information of the sender stored in association with the email address of the user (Ralston, figure 6A “store mail in user’s inbox 684”).

Ralston does not explicitly disclose a processor configured to direct the terminal station to transmit a request to register the email address of the user as a recipient email address at a transmitting apparatus of the sender identified with the identification information; and that the second communication network different from the first communication network;

Wilson teaches an email system with active filter that provides a way to control the user’s terminal to display a pop-up window to prompt for user’s decision whether to receive an email from a particular sender or not (Wilson, page 7 [0087]).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have modified the Ralston email system to prompt for

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user's response in deciding whether to receive messages from senders not currently on the list, in order to automate the process of entering new sender into a list of allowed or blocked senders without extra effort from the user and therefore register that the user's email is the recipient of that sender.

Castell discloses an email message delivering system that filters message passing between second communication network and first communication network that are different networks (Castell, [0009] and [0030], figure 1 "Internet 10" and "wireless network 80").

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have extended Ralston in view of Wilson teachings to include Castell's explicit disclosure of two different communication networks in order to provide email filtering service to mobile device users to prevent damage done by unsolicited emails (Castell, [0007]).

8. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) in view of Wilson (U.S. Patent Application Publication No. 2004/0015554) and in view of Castell et al. (US 2002/0132607) as applied to claim 25 above, and further in view of Druckenmiller et al. (US 6167435).

As per claim 26, (New) Ralston in view of Wilson in view of Castell, hereinafter referred to as modified Ralston discloses the relay apparatus of claim 25, wherein the identification information is included in a first file generated with the transmitting apparatus and configured to provide a display on the terminal station (Ralston, figure 4).

The modified Ralston does not explicitly disclose generating and transmitting a request for identifier of the terminal station.

Druckenmiller discloses such limitation (Druckenmiller, figure 3, column 3 lines 40-54).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have modified the modified Ralston's email system to prompt for user's response in deciding whether to register to receive messages from senders not currently on the list, in order to allow user to receive bulk emails that maybe of interest.

As per claim 27, (New) The modified Ralston in view of Druckenmiller discloses the relay apparatus of claim 26, wherein the identifier of the terminal station is a telephone number of the terminal station, and the relay apparatus is further configured to identify the email address of the user of the terminal station based on the telephone number, and store the identification information in association with the telephone number and the email address of the user (Druckenmiller, column 8 lines 49-65).

As per claim 28, (New) The modified Ralston in view of Druckenmiller discloses the relay apparatus of claim 25, wherein the processor is further configured to generate and transmit to the terminal station a delivery permission to transmit the request (Druckenmiller, figure 3, column 3 lines 40-54), the delivery permission registration screen comprising a user selection selectable by the user to initiate generation and transmittal to the transmitting apparatus of the request to register the email address of the user at the transmitting apparatus (Druckenmiller, figure 3, column 3 lines 40-54).

9. Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (US 6842773) in view of Druckenmiller et al. (US 6167435).

As per claim 29, (New) Ralston discloses a method of selectively delivering email messages to a terminal station (Ralston, column 4 lines 27-34), the method comprising:

a relay device communicating with the terminal station over a first communication network (Ralston, figure 2 "mail system 112");

the relay device also communicating with an information providing server over a second communication network (Ralston, figure 2 "Unsolicited Mailer 104");

the relay device receiving from the terminal station identification information of the information providing server (Ralston, column 4 lines 66-67 and column 5 lines 1-3), the identification information obtained by the terminal station from the information providing server (Ralston, column 3 lines 40-44);

the relay device storing the identification information in association with an identifier of a user of the terminal station (Ralston, figure 2 "Approved List 216", "Block List 244");

the relay device receiving over the second communication network an email addressed to the user of the terminal station based on registration by the terminal station with the information providing server (Ralston, column 10 lines 37-46);

confirming with the relay device that the email includes the identification information of the information providing server stored in association with the identifier of the user of the terminal station (Ralston, column 9 lines 44-54 “approved list 216”); and the relay device, responsive to confirmation, relaying the email to the terminal station over the first communication network (Ralston, column 9 lines 44-54 “stored in the mail account of the user 116”).

Ralston reference does not explicitly teach step of directing the terminal station to register with the information providing server to receive communications from the information providing server.

Druckenmiller discloses such limitation (Druckenmiller column 3 lines 40-54).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have modified the Ralston email system to prompt for user's response in deciding whether to receive messages from senders not currently on the list, in order to automate the process of entering new sender into a list of allowed senders by prompting registering of the user's email as recipient of the desired bulk email sender.

As per claim 30, (New) Ralston in view of Druckenmiller discloses the method of claim 29, further comprising transmitting a service registration request for receipt by the information providing server (Druckenmiller, column 3 lines 7-10), and receiving with the terminal station from the information providing server the identification information of the information providing server in response to the service registration request (Druckenmiller, column 3 lines 37-39, figure 3).

As per claim 31, (New) Ralston in view of Druckenmiller discloses the method of claim 30, wherein receiving with the terminal station the identification information comprises displaying a process instruction screen on the terminal station (Druckenmiller, figure 3), and generating and transmitting to the relay device a relay registration request that includes the identification information in response to receipt of a user selection from the process instruction screen (Ralston, column 10 lines 36-46 “user assents to receiving the e-mail broadcast”).

As per claim 32, (New) Ralston in view of Druckenmiller discloses the method of claim 29, wherein the relay device directing the terminal station to register with the information providing server comprises the relay device transmitting a file for receipt and display by the terminal station, the file comprising a user selection to initiate registration, and code responsive to selection by the user of the user selection to generate and transmit a registration request to the information providing server (Druckenmiller, figure 3, column 3 lines 40-54).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUPAPORN NILANONT whose telephone number is (571) 270-5655. The examiner can normally be reached on Monday through Thursday and alternate Friday at 8:30 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Y. N./

Examiner, Art Unit 2446

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446